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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

RCA 89462

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on

May 22, 2006

Signature

Eliza Buchalczyk

Typed or printed name

Eliza Buchalczyk

Application Number

09/936,415

Filed

02/01/2002

First Named Inventor

Eskicioglu

Art Unit

2131

Examiner

Longbit Chai

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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attorney or agent of record.

Registration number

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

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May 22, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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*Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: A. M. Eskicioglu, et al.
Ser. No.: 09/936,415
Filed: February 01, 2002
For: A GLOBAL COPY PROTECTION SYSTEM FOR DIGITAL HOME NETWORKS
Examiner: Longbit Chai
Art Unit: 2131

Mail Stop AF
Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450.

ARGUMENTS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pre-Appeal Brief Review has been requested in the above-captioned application, as identified in the accompanying Form PTO/SB/33, for the clear errors listed below in the rejection of: (1) Claims 1, 2, 5, 8 and 14 under 35 U.S.C. 102(e) as being anticipated by Tsuria (U.S. Patent No. 6,178,242); and, (2) Claims 3, 4, 6-7, 10-13, and 17-20 under 35 U.S.C. 103(a) as being unpatentable over Tsuria in combination with other references. In view of these clear errors, there is no *prima facie* case of anticipation or obviousness as to any of these pending claims, such that allowance thereof is respectfully requested.

Clear Error (1): Claim 1 is not anticipated under 35 U.S.C. 102(e) in view of the Tsuria reference, as Tsuria fails to disclose or suggest each and every limitation of the present claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *See, Verdegaaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).* In the instant case, the Examiner makes clear error with respect to operation of the system disclosed in Tsuria, and has improperly resorted to speculation and unfounded assumptions to remedy deficiencies in the factual basis for the rejection.

Claim 1 calls for: (1) a first device to: (a) receive said scrambled program including a scrambled data component and a descrambling key; and (b) rebundle the descrambling key

using a unique key associated with the first device; and (2) a second device to: (c) receive the scrambled data component and the rebundled descrambling key; (d) obtain the descrambling key from the rebundled descrambling key; and (e) descramble the scrambled data component using the descrambling key. Tsuria clearly fails to teach first and second devices performing these steps in such a manner (e.g., a first device performing steps (a)-(b) and a second device performing steps (c)-(e)).

In contrast, Tsuria discloses an integrated receiver-decoder (IRD) 110 that: (1) receives a scrambled digital data stream (SDDS) from a broadcast source (*see, col. 7, ll. 34-35*); (2) produces a recording SDDS (*see, col. 8, ll. 2-3*); (2) obtains ECMs and TECMs (*see, col. 7, ll. 48-51, col. 9, ll. 30-36*); and (3) descrambles SDDSs using the ECMs and TECMs (*see, col. 7, ll. 51-57, col. 9, ll. 30-36*). Tsuria further discloses a digital VCR 130 that merely records and plays back recorded scrambled digital data streams (SDDSs) through IRD 110 (*see, col. 7, ll. 8-20, col. 9, ll. 30-36*). As expressly taught in col. 9, lines 30-36 of Tsuria and demonstrated in Fig. 1 (reproduced below), during playback of a recording SDDS from the digital VCR 130 through the IRD 110 to the television 100, the IRD 110 and the associated smart card 120 (and not the VCR 130) perform descrambling operations using the TECM key.

The Final Office action equates IRD 110 of Tsuria to the first device recited in Claim 1, and VCR 130 of Tsuria to the second device recited in Claim 1. *See, 10/18/2005 Office action, par. 3.* However, VCR 130 of Tsuria cannot be properly equated to the recited second device of Claim 1, as it fails to either “(d) obtain the descrambling key from the rebundled descrambling key; [or] (e) descramble the scrambled data component using the descrambling key” – as the TECM is determined and the SDDS descrambled at IRD 110. *See, col. 7, ll. 48-57, col. 9, ll. 30-36.*

The Examiner clearly erred by resorting to speculation and unsupported allegation in asserting that “the [VCR 130] ***must be able*** to descramble the scrambled data component using [the] descrambling key ... (i.e. TECM key) [and] decoupling functions (i.e. descrambling) must be performed on the [VCR 130] ... ; ***otherwise the system can not work properly.***” *Final Office action, par. 3 (emphasis added).* This assertion is simply incorrect. VCR 130 does not, and need not, descramble the recording SDDS to work properly, as playback of recorded content is accomplished through IRD 110, and not directly between VCR 130 and display 100. *See, Fig. 1 reproduced below.* Further, Fig. 1 of Tsuria clearly shows the recording format SDDS (TECM protected content) is bi-directional between IRD

110 and VCR 130, and that only the IRD 110, and not VCR 130, provides any signaling to display 100.

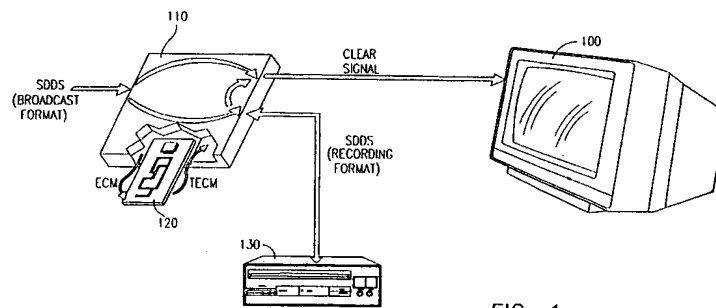


FIG. 1

The Examiner also clearly erred by stating “the similar operations similar to those performed on a broadcast SDDS [on a recording SDDS] *is only [sic]* the scrambling part of functions while the decoupling functions (i.e. descrambling) *must* be performed on the respective receiving device coupled to the first device.” *Final Office action, par. 3 (emphasis added)*. Again, the above is factually incorrect. In contrast, Tsuria expressly teaches IRD 110 descrambles the SDDS content for display. *See, col.7, ll. 23-30, 51-57*. And, that during playback from VCR 130 through IRD 110, IRD 110 performs similar functions as in the case of a broadcast SDDS. *See, col. 9, ll. 30-36*. In particular, Tsuria expressly teaches descrambling operations are performed by the apparatus of Fig. 3 in parallel with the production of the recording SDDS. *See, col. 9, l. 66-col. 10, l. 3*. And, that the recording SDDS can be descrambled by instead providing it, and the TECM key, to the apparatus of Fig. 3. *See, col. 10, ll. 10-16*.

Thus, the Examiner clearly erred by assuming that the Tsuria VCR 130 must somehow be able to descramble the TECM protected content in order to work¹, and thus improperly rejected Claim 1 under 35 U.S.C. 102(e) as being anticipated by Tsuria. Reliance upon the express teachings of Tsuria reveals that IRD 110 and not VCR 130 descrambles protected content. Hence, Tsuria does not and cannot anticipate present Claim 1.

Clear Error (2): The Examiner has improperly resorted to the same speculation and unfounded assumptions to remedy the same deficiencies in the factual basis for the rejection of Claim 10 as being unpatentable over Tsuria in combination with Wasilewski.

¹ The Examiner may not resort to speculation and unfounded assumptions to supply deficiencies in the factual basis for the rejection. *See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968)*.

Like Claim 1, Claim 10 calls for first and second devices, in that it recites an access device to: (a) receive scrambled program content, (b) decrypt a descrambling key; and (c) re-encrypt the descrambling key; and a presentation device to: (d) receive the scrambled data and re-encrypted key; (e) decrypt the re-encrypted key; and (f) descramble the content.

Wasilewski is not relied upon to remedy the aforementioned deficiencies of Tsuria.

Accordingly, a *prima facie* case of obviousness with respect to Claim 10 has not been presented.

Clear Error (3): The Examiner has improperly resorted to the same speculation and unfounded assumptions to remedy the same deficiencies in the factual basis for the rejection of Claim 12 as being unpatentable over Tsuria in combination with Wasilewski. Claim 12 calls for first, second and third devices, in that it recites an access device to: (a) receive scrambled program content, (b) decrypt a descrambling key; and (c) re-encrypt the descrambling key; and for a recording device to: (d) receive the scrambled data and re-encrypted key; and (e) provide the scrambled data component and re-encrypted key to a presentation device. Again, Wasilewski is not relied upon to remedy the above-discussed deficiencies of Tsuria. Tsuria merely teaches VCR 130 receives protected content from and provides protected content to a single device, IRD 110 – and not from and to different access and presentation devices. Accordingly, a *prima facie* case of obviousness with respect to Claim 12 has not been presented.

Clear Error (4): Finally, the Examiner has improperly resorted to the same speculation and unfounded assumptions to remedy the same deficiencies in the factual basis for the rejection of Claim 17 as being unpatentable over Tsuria in combination with Wasilewski. Claim 17 calls for an access device comprising, in part, an encryption unit for re-encrypting the descrambling key using a public key associated with a presentation device, wherein only the presentation device has a corresponding private key to decrypt the re-encrypted scrambling key and descramble scrambled content. Again, Wasilewski is not relied upon to remedy the above-discussed deficiencies of Tsuria. Further, Tsuria merely teaches a single-device (IRD 110) that both re-encrypts the scrambling key and decrypts the re-encrypted key and descrambles the content – and not different access and presentation devices. Accordingly, a *prima facie* case of obviousness of Claim 17 has not been presented.

Conclusion: Reversal of the Examiner as to Clear Error 1 is sufficient to negate the *prima facie* case of anticipation as to independent Claim 1, and thus render Claim 1, and Claims 2-8, which depend from Claim 1, allowable. Reversal of the Examiner as to Clear

Error 2 is sufficient to negate the *prima facie* case of obviousness of independent Claim 10, and thus render Claim 10 allowable. Reversal of the Examiner as to Clear Error 3 is sufficient to negate the *prima facie* case of obviousness of independent Claim 12, and thus render Claim 12 and Claim 13, which depends from Claim 12 allowable. Reversal of the Examiner as to Clear Error 4 is sufficient to negate the *prima facie* case of obviousness of independent Claim 17, and thus render Claim 17 and Claims 18-20, which depend from Claim 17, allowable.

Accordingly, allowance of the present case on the existing claims is respectfully requested. Should there be any questions or outstanding matters, the Examiners are cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,

AHMET MURSIT ESKICIOGLU, ET AL.



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